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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/784,224

Applicant(s)
Sullivan

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 22, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 5, 10, 13, 14, 16, 20, 21, and 25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 5, and 10 is/are allowed.
- 6) ☒ Claim(s) 13, 14, 16, 20, 21, and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Decision on Appeal

1. The Decision on Appeal of September 24, 2002 finally disposed of Claims 1-3, 6-9, 11, 12, 15, 17-19, 22, 24, and 26-28; therefore, prosecution of these claims is terminated. Claims 4, 5, 10, 13, 14, 16, 20, 21, and 25 remain active in the application.

Claim Objections

2. The Decision finally disposed of all of the independent claims rendering the remaining claims dependent upon canceled claims. These claims need to be rewritten in independent form. The following action is based on all of the limitations of the dependent claim and its parent(s) prior to the Decision.

Response to Amendment

3. As agreed upon during the telephonic interview of April 22, 2003, the Applicant has submitted an amendment writing the remaining claims in independent format; thus overcoming the above objection.

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Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 13, 14, 16, 20, 21, and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13, 14, 16, 20, 21, and 25 have no connection to the technological arts. None of the steps of the method claims (20, 21, and 25) indicate any connection to a computer or technology. Furthermore, none of the apparatus claims (13, 14, and 16) recite any physical devices of which the apparatus is supposedly composed, but merely recite a knowledge matrix, a control module, a knowledge worker grid, a process grid, and a data grid which perform the steps of the method claims. The Examiner notes that even if it was assumed that this was some sort of computer apparatus these are merely stored data or computer programs and not the actually apparatus on which they are being run. A proper apparatus claim for a computer implemented invention should include such devices as a computer processor, electronic databases, input/output devices, etc.

The steps of the method claims (and the functions of the apparatus claims) consist of receiving a first request, retrieving status information, generating a second request, and receiving the desired information. These steps could all be performed manually without any technological intervention by a person manually (e.g. verbally) receiving a request from a user for an item of

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information, looking in an index (e.g. a card file) to see if the information was available, generating a second request by asking a co-worker to retrieve the information, and receiving the information from the co-worker. An example of such a “system” would be a public library where a customer would approach the librarian and ask for a specific book. The librarian would look up the book in the library’s card file to see if it was available in the library. If it was, the librarian would then ask one of her co-workers to retrieve the book for the customer. The co-worker would then deliver the book to the librarian. This same manual example could be expanded to include a book which was not present in the library in which case the librarian would determine from the card file that the book was available in another library and generate the second request asking the other library to forward the book to the first library. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection, the Examiner recommends the Applicant amend the claims to better clarify which of the steps are being performed within the technological arts by incorporating a computer processor and electronic database into the receiving and retrieving steps, such as (using Claim 20 as an example) “receiving a first request over a computer network from a client computer associated with the knowledge worker; retrieving, from a knowledge matrix, status information on a knowledge item in an electronic database associated with the first request;” etc. The apparatus claims could be amended as suggested above to include the actual electronic devices being used.

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Allowable Subject Matter

6. Claims 4, 5, 13, 14, 20, and 21 contain allowable subject matter.

7. The following is a statement of reasons for the indication of allowable subject matter:

As discussed in the Decision on Appeal of September 24, 2002, prior art was found which disclosed all of the claimed features except the feature in Claims 4, 5, 13, 14, 20, and 21 pertaining to identifying a plurality of needs for the knowledge worker. While the references disclose the user (knowledge worker) entering a plurality of search criteria for the desired (needed) information, the Board has determined that this is not the equivalent of a plurality of needs for the knowledge worker. Therefore, this is the novel feature of the invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oku et al (5,675,745) in view of Graves et al (5,410,344), Barritz (5,499,340), and Itakura et al (6,351,745).

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Claims 10, 16, and 25: Oku discloses a knowledge management system, apparatus, and method comprising:

- a. A client which generates a first request (query) for a knowledge worker (user)(col 21, lines 5-26);
- b. A server which receives the first request and generates a second request to the information source (database) when information pertaining to the location of the knowledge item is found in the knowledge matrix (DBMS index)(col 21, lines 5-26); and
- c. An information source (database) which responds to the second request by communicating the information requested by the first request to the server (col 21, lines 5-26).

However, Oku does not explicitly disclose generating access statistics in response to the above interactive session nor modifying a personal profile of the knowledge worker (user) in response to the access statistics. Graves discloses a similar system, apparatus, and method for tracking viewer (knowledge worker) access of audiovideo programs which compiles a personal profile for each viewer (col 5, lines 46-66). After each “access” the viewer rates the knowledge item (audiovideo program), and the correspond rating score is used to update the viewer’s personal profile (col 7, lines 49-54). Barritz also discloses a similar system, apparatus, and method which monitors and tracks the frequency of user access to computer program and software products (col 1, lines 8-10) and further discloses several methods that could be used as a watch module for capturing data to determine the proportional usage by any one of numerous programs/products available. Therefore, it would have been obvious to one having ordinary skill

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in the art at the time the invention was made to generate (and compile) access statistics on Oku's client's usage. One would have been motivated to capture client access statistics in view of Oku's description of "client environments" and Graves' description of using personal profiles for tracking viewer access scores.

However, the Decision concluded that none of the references explicitly disclose that the personal profiles are modified "in response to the access statistics". The Examiner notes that the Applicant has described "access statistics" in the specification as "times, URLs, knowledge worker inputs, activity sequences, and other information" (page 11, lines 31-32) which are used "to develop an historical footprint of the knowledge worker's activities in system 10" (page 11, lines 32-34). This data is then used by the watch module to "modify the personal profile 30 to customize the individual view or menus presented at the beginning of a session (page 12, lines 5-7) and "the watch module 34 continues to adjust personal profile 30 based on the knowledge worker's use of system 10 as an account manager" (page 12, lines 20-23). Itakura discloses a similar system, apparatus, and method for tracking user access to messages and websites which stores a personal profile (user database)(col 3, lines 33-52) which is used to determine the appropriate message(s) to transmit to the user (col 5, lines 50-60). As the user accesses messages the system updates the value of a stored "parameter, which corresponds to the frequency of accessing messages" (i.e. access statistic)(col 3, lines 61-62). Thus, Itakura is not only tracking access statistics, but is also updating the personal profile by adjusting the value of the user's parameters each time the user accesses one or more messages and then using the updated personal

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profile to select appropriate messages during subsequent sessions with the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such a method to update a personal profile based on access statistics by the user in Oku. One would have been motivated to track and update a personal profile in this manner in order to present the user with the most pertinent message/website/knowledge item as discussed in Itakura (col 5, lines 59-60).

Conclusion

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM

July 1, 2003

approved JKL
JOHN J. LOVE
DIRECTOR
TECHNOLOGY CENTER 3800